



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/613,627

07/02/2003

W. Jeffrey Mitchem

MCD118 CIP

4350

48929 7590 09/27/2007
HENSLEY KIM & HOLZER, LLC
1660 LINCOLN STREET
SUITE 3000
DENVER, CO 80264

EXAMINER

QURESHI, AFSAR M

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,627

Applicant(s)

MITCHEM ET AL.

Examiner

Afsar M. Qureshi

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8 and 13-23 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 9-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This Office Action is responsive to amendment/Arguments received on 7/18/2007. Claims 1-23 remain pending in the Application.

Response to Arguments

2. Examiner note that double patenting rejection under *in re Schneller* requires prior approval from Technology Center Director. It was not the Examiner's intention to use *in re Schneller* as basis for double patenting rejection but a mere reference that it might be applicable. However, in light of the arguments, Examiner has withdrawn paragraphs referring to *in re Schneller* from previous Office Action, dated 4/18/2007.

Applicant's arguments, in reference to obviousness type nonstatutory double patenting rejection of claims 1, 5-8 and 12-23 have been fully considered but they are not persuasive.

Double patenting rejection, as below, is based on subject matter *claimed* in the instant application that is fully disclosed and covered in the patent (Mitchem et al. US 6,608,819). Applicant argued that terms (e.g., template) are not the same as claimed in the instant application. Examiner, respectfully, disagrees. All the terms and equivalents used in the double patenting rejection are obvious to one of ordinary skill in the art to be carrying the same meaning as claimed herein. For example, Mitchem claimed, "examining the predetermined data with data templates ...", in claim 22, is same as comparing the data with data template, as claimed herein. Only after comparing the selected data is bit-wise ANDed with a data mask.

Examiner contends the following standard nonstatutory double patenting rejection of claims 1, 5-8 and 12-23 is still applicable.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5, 6-8 are rejected on the ground of nonstatutory double patenting over claims 22, 10, 11 and 12 of U. S. Patent No. 6,608,819 (Mitchem et al.) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter of Claims 1 and 5 of the current Application, for example, "receiving a frame containing a content; comparing ...; determining...; assigning a QoS

Art Unit: 2616

score...; and transmitting the data frame... (of claim 1) and further limitations of establishing an initial score... ; and adjusting the initial scores with one or more alternative score components to determine one or more adjusted scores”, is claimed in Patent No. 6,608,819, claim 22.

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claim 1 and 5 of the instant application the “receiving a data frame containing content” is not distinct from the “receiving the frames at one or more fiber channel switches” in claim 22 of the Patent ‘819, since it is obvious to one of ordinary skill in the art that all frames have content such as shown in figure 3. Similarly, “comparing of the content with a template” is not distinct from the limitation “comparing the predetermined data with template”.

Similarly, Claims 6, 7 and 8 of the current Application contain same subject matter as claimed in US Patent No. 6,608,819, claims 10, 11 and 12, respectively. For instance, claim 10 of US 6,508,819 covers limitations of “receiving the frame; evaluating a content of the frame;; selecting a frame having a highest QoS value (score); and transmitting said selected frame through the switch, wherein claim 6 of the application claims, “assigning a QoS score to the frame”, it would be obvious to one of ordinary skill in the art that “assigning an *initial score* to said frame” (US 6,608,819) is same limitation as claimed herein (see ‘819, col. 4, lines 48-50) wherein “initial score” is assigned to the data using a QoS value.

Also, the limitations of claims 7 and 8 of the application correspond to claims 11 and 12, respectively, of the aforementioned US patent and therefore it would have been

obvious to one of ordinary skill in the art at the time of invention to claim alternative wording but having the same meaning (initial score instead of QoS).

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as above. Claims 1, 5, 6-8, if allowed would improperly extend the "right to exclude" already granted in the patent.

4. Claims 13-23 are rejected on the ground of nonstatutory double patenting over claims 2-11 of U. S. Patent No. 6,233,236 (Nelson et al.) Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The subject matter of claim 13, of instant Application is already claimed in the patent claim 1 of U. S. Patent No. 6,233,236. The "fiber channel switch" claimed herein is no different than the "*switch*" in claim 1 of the above mentioned US patent (see Field of Invention, col. 1, lines 5-10).

The patent claim 1, does not claim the limitation of "means for associating a quality of service value with the frame based upon the metadata matching the template held in the second register", as claimed herein.

However, it would have been obvious to one of ordinary skill in the art, at the time of invention, to be able to associate at least one parameter, i.e., QoS, with the frame

(such as FC-4) based upon the entire data that matches the template since the invention is concerned with monitoring the user specified frame type sent by the source in a switch wherein it is already claimed, in claim 1 of the patent that template is held in second register.

The subject matter of claim 14, of instant Application is already claimed in claim 2 of U. S. Patent No. 6,233,236

The subject matter of claim 15, of instant Application is already claimed in claim 3 of U. S. Patent No. 6,233,236

The subject matter of claim 16, of instant Application is already claimed in claim 4 of U. S. Patent No. 6,233,236.

The subject matter of claim 17, of instant Application is already claimed in claim 5 of U. S. Patent No. 6,233,236.

The subject matter of claim 18, of instant Application is already claimed in claim 6 of U. S. Patent No. 6,233,236.

The subject matter of claims 19, of instant Application is already claimed in claim 7 of U. S. Patent No. 6,233,236 for the same reasons as discussed in the rejection of claim 13 above.

The subject matter of claim 20 of instant Application is already claimed in claim 8 of U. S. Patent No. 6,233,236.

The subject matter of claim 21, of instant Application is already claimed in claim 9 of U. S. Patent No. 6,233,236.

The subject matter of claim 22, of instant Application is already claimed in claim 10 of U. S. Patent No. 6,233,236.

The subject matter of claim 23, of instant Application is already claimed in claim 11 of U. S. Patent No. 6,233,236.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as above. Claims 13-23, if allowed would improperly extend the "right to exclude" already granted in the patent.

5. Claims 2-4 and 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2616

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Afsar M. Qureshi whose telephone number is (571) 272 3178.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Field Lynn can be reached on (571) 272 2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


AFSAR QURESHI
PRIMARY EXAMINER

9/20/2007